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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,683	07/16/2004	Hiroshi Maruyama	5271-0107PUS1	2757
2292 7590 02/26/2008 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER SCULLY, STEVEN M				
ART UNIT 4132		PAPER NUMBER		
NOTIFICATION DATE 02/26/2008		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

# Office Action Summary

**Application No.**

10/501,683

**Applicant(s)**

MARUYAMA, HIROSHI

**Examiner**

Steven Scully

**Art Unit**

4132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 July 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/IS/C)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☒ Other: Online translation of JP11-176400
- Paper No(s)/Mail Date: 10/18/2004, 7/16/2004

## DETAILED ACTION

### *Drawings*

1. Figure 9 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoichiro et al. (JP11(1999)-176400A, cited in IDS, refer to online translation). Additional supporting evidence is provided by Applicant's disclosure.

Regarding claims 1 and 8 (see Figure 3), Yoichiro is directed to a card-shaped thin battery comprising:

- A battery module (1); and

- An outer case for housing the battery module, the outer case comprising:
- A first case body (2) comprising connection walls;
- A second case body (3) comprising connection walls, wherein the connection walls of the first case body and second case body connect the first case body and the second case body to each other on outer circumferential portions. In instant's specification (Page 1, Lines 10-28), applicant discloses that the outer casing of Yoichiro is a connection of the first case body to the second case body in a lid-fitting manner, indicating that the connection is made on outer circumferential portions of the casing.

- At least one selected from the first case body and the second case body comprising:
  - A dish-shaped case element (2b, 3b) with a housing portion swelling from one surface; and
  - A reinforcing frame (2c, 3c) fixed to the dish-shaped case element along a circumference of a swelling wall of the housing portion, wherein the reinforcing frame is a plastic molding, and the case element is a press-formed product made of a metal thin plate formed so as to be integrated with the reinforcing frame. This limitation is met in instant's specification (Page 1 Lines 21-24), in that Yoichiro discloses: "The upper and lower cases 31a and 31b (applicant's Figure 9) respectively are composed of a plate-shaped case wall member 35 obtained by press-forming an aluminum plate material and plastic

frames 36 fixed to front and back sides of four circumferential portions of the case wall member 35."

- Wherein the battery module (1) is housed within the housing portion, and sealed in the outer case by attaching the connection walls of the first case body to the connection walls of the second body. In instant's specification (Page 1, Lines 10-28), applicant discloses that the outer casing of Yoichiro is a connection of the first case body to the second case body in a lid-fitting manner, indicating that the connection is made on outer circumferential portions of the casing.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoichiro et al. (JP11(1999)-176400A) as applied to claim 1 above, and further in view of Hasegawa et al. (US 6,319,630).

Regarding claim 3, Yoichiro teaches all of the limitations of claim 1, but is silent regarding a mounting region formed on an outer surface of the connection wall adjacent to the swelling wall of the housing portion, wherein the mounting region comprises a control module for the battery module and a cover for protecting the control module.

Hasegawa teaches a nonaqueous electrolyte battery capable of realizing a sufficiently large space for accommodating a control circuit (5, i.e. control module) and prevent enlargement of the size thereof. The battery element has terminal leads (3 and 4) for the electrodes which are in contact with a control circuit (Figure 16, paragraph [0050], a printed circuit board (5a) provides an input for the terminal leads to be electrically connected to the control circuit). The control circuit is held at a position adjacent to the battery module (1) in a region provided for mounting the control circuit. The control circuit of Hasegawa is protected by a cover (see Column 3, Lines 57-60 discussing a decorative casing (cover); it is understood that a cover would inherently be attributed with protective characteristics).

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the control circuit of Hasegawa to the battery element of Yoichiro for the benefit of regulating the electrical flow from the battery to the apparatus in which the battery is to be mounted.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoichiro et al. (JP11(1999)-176400A) modified by Hasegawa et al. (US 6,319,630) as applied to claim 3 above, and further in view of Koza et al (EP1033766A1, listed in IDS).

Regarding claim 4, Yoichiro modified by Hasegawa discloses all the limitations of claim 3 as well as output terminals on the control module and a protection circuit, but is silent about the control module comprising input terminals, and a pair of the input terminals of the control module are connected to be fixed to a positive tab and a negative tab of the battery module.

Koza discloses a battery pack in a casing with a battery protection device (8) comprising safety unit (4) in which a protection circuit is constituted on a circuit board (14) for protecting the battery from over-discharging or over-charging. The battery protection device has input/output terminals (6a, 6b, 6c) that are mounted on the case for contacting to the outputs from the circuit board (14). Also, there is a positive electrode connection lead (30) and negative electrode connection lead (33) on the battery protection device contacting the electrodes (12 and 13) of the battery pack providing input terminals to the battery protection device (see Column 8, Line 45-Column 11, Line 37).

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the control module of Yoichiro modified by Hasegawa with the design of Koza's terminal connections from the battery to the control module (battery protection device) for the benefit of having a negative and a positive input to the control module from the battery module.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoichiro et al. (JP11(1999)-176400A) modified by Hasegawa et al. (US 6,319,630) as applied to claim 3 above, and further in view of Kaneda et al. (US 6743546, with priority to WO0059063, refer to US6743546 for translation).

Regarding claim 5, Yoichiro modified by Hasegawa discloses all the limitations of claim 3 as well as that the outer case is formed in a rectangular card shape (see Yoichiro's Figures 1 and 2; see Hasegawa's Figures 1 and 16), the mounting region is provided on one side of the outer case (see Hasegawa's Figure 1) and terminal windows for exposing the output terminals of the control module are opened in the principal plane wall (5; see Hasegawa's Figure 1 in which the control circuit is provided with a upper wall exposing the output terminals), but does not teach the cover comprising a principal plane wall covering an outer surface of the control module having a pair of leg chips projecting from both ends of the principal plane wall.

Kaneda discloses a laminate sheath type thin battery with a protective sheath (see Figure 7). The sheath is provided with legs (40, 41) on each side for accommodating side edges of an electrode assembly (2). The electrodes (13, 14) of said assembly are provided with an open area between protective pieces (31, 32). "The electrode assembly fixing means is a frame surrounding the periphery of the electrode assembly and accommodated within the casing with the electrode assembly. The frame includes:

an abutment portion making contact with one end face of the electrode assembly from which the positive and negative electrode terminals extend, the



abutment portion being formed with through holes for passing through the positive and negative electrode terminals,

a pair of legs extending from both ends of the abutment portion to cover both side faces of the electrode assembly, and

a pair of protective pieces extending from opposite side edges of the abutment portion in a direction opposite from the pair of legs so as to cover joints between the positive and negative electrode terminals and their respective leads from both sides.” (Column 5, Lines 30-47)

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the casing of the control module in Yoichiro modified by Hasegawa with extended legs on the protective cover of the protection circuit, as well as to the positive and negative electrodes for the benefit of the cover joint portion protecting the circuit and the electrodes, as well as for the benefit of providing the structure with an increased rigidity.

9. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoichiro et al. (JP11(1999)-176400A) as applied to claim 1 above, and further in view of Higuchi (US 6,154,004).

Regarding claim 6, Yoichiro teaches all the limitations of claim 1, but is silent about a concave portion for preventing reverse insertion further being formed on one side of the outer case, wherein the concave portion is engaged with a convex portion for

preventing reverse insertion provided in a battery insertion portion of an apparatus in which the battery is to be mounted.

Higuchi teaches a battery pack (10) with a concave surface (17) and a camera which has a convex portion to be coupled with the battery to prevent reverse insertion of the battery into the camera (Figure 2; Column 4, Lines 31-48).

It would have been obvious to one skilled in the art at the time of the invention to provide the battery pack of Yoichiro with the reverse insertion prevention tool taught by Higuchi for the benefit of preventing the battery from being inserted into the electronic apparatus incorrectly.

Regarding claim 7, Yoichiro teaches all the limitations of claim 1, but is silent about a concave portion for preventing dropping formed on one side of the outer case, wherein the concave portion is engaged with the convex portion for preventing dropping provided in an apparatus in which the battery is to be mounted.

Higuchi teaches a battery pack (10) provided with connecting grooves (16a-16d) on the side of the lower case part (15) of the battery pack (10) and connecting projections on the video camera wherein a locking projection of the battery fitting part of the video camera is connected with a locking concave part of the battery pack to maintain the fitting (Figure 2; Column 4, Lines 49-59).

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the fittings of Higuchi singularly or in a plurality onto the battery pack of Yoichiro for the benefit of locking the battery in place so it is not expelled from the electronic device undesirably.

***Contact/Correspondence Information***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Scully whose telephone number is (571)270-5267. The examiner can normally be reached on Monday to Friday 7:30am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jessica Ward can be reached on (571)272-1223. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. S./  
Examiner, Art Unit 4132

/Jessica Ward/  
Supervisory Patent Examiner, Art Unit 4132